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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,732	11/01/2001	Leif Andersson	2183-4951US	6509
24247	7590	02/14/2007		
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			EXAMINER ANGELL, JON E	
			ART UNIT	PAPER NUMBER
			1635	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/868,732	Applicant(s) ANDERSSON ET AL.	
	Examiner Jon Eric Angell	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed 11/16/2006 is acknowledged and has been entered.

Claim 46 is currently pending in the application and are addressed herein.

1. Applicant's arguments are addressed on a per section basis. The text of those sections of Title 35, U.S. Code not included in this Action can be found in a prior Office Action. Any rejections not reiterated in this action have been withdrawn as being obviated by the amendment of the claims and/or applicant's arguments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 47 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for:

A method for selecting a pig for breeding by identifying a pig having a paternally imprinted quantitative trait locus (QTL) associated with larger muscle mass **AND** decreased fat deposit such that when said pig is used in a breeding program, the offspring of the pig that inherit said QTL from the male parent have larger muscle mass **AND** decreased fat deposit compared to controls, wherein the method is as indicated in current claim 47 wherein the identification of the pig having the paternally imprinted QTL associated with larger muscle mass **AND** decreased fat deposit selects the pig for breeding.

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does not reasonably provide enablement for the full scope encompassed by the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the claimed invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described by the court in *In re Wands*, 8 USPQ2d 1400 (CA FC 1988).

Wands states on page 1404,

“Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

The instant claims are drawn to a method for selecting a pig for breeding by selecting a pig which has paternally imprinted QTL associated with larger muscle mass or decreased fat deposit. Regarding the breadth of the claims, the claims encompass identifying a QTL associated with EITHER larger muscle mass OR decreased fat deposit, but not necessarily both.

It is acknowledged that the specification discloses that the paternally imprinted QTL is associated with larger muscle mass AND decreased fat deposit (e.g., see page 10 lines 21-22). Furthermore, the data disclosed in the specification appears to indicate that the QTL is associated with both larger muscle mass as well as decreased fat deposit (e.g., see Table 1, Figure 3, etc.). There is no evidence found in the specification or the prior art which indicates that the disclosed QTL can be associated with larger muscle mass independent of fat deposit, or that the QTL can be associated with decreased fat deposit independent of muscle mass, as encompassed by the

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claims. Since the QTL only appears to be associated with both larger muscle mass AND decreased fat deposit, additional experimentation would be required in order to determine if the disclosed paternally imprinted QTL can be associated with either larger muscle mass OR decreased fat deposit without being associated with the other, a finding which would appear to differ from that the disclosed data. Furthermore, a finding that the QTL could associated with either larger muscle mass or decreased fat deposit with being associated with the other would bring into question if the and when the QTL could be associated with both larger muscle mass and decreased fat deposit.

Response to Arguments

With respect to the instant rejection, Applicants argue that the claim has been amended per the Examiner's suggestion and should obviate the rejection.

However, claim 47 still encompasses a method for selecting a pig for breeding by selecting a pig which has paternally imprinted QTL associated with larger muscle mass and/or decreased fat deposit. Regarding the breadth of the claims, the claims encompass identifying a QTL associated with EITHER larger muscle mass OR decreased fat deposit, but not necessarily both.

Therefore applicants arguments are not persuasive.

It is noted that a telephone call was made to Applicants representative (Allen Turner) on February 1, 2007 in order to offer amending the claim by Examiner's Amendment. However, Mr. Turner was out of the Office until Monday February 5. Since an action was due February 5, the Examiner could not wait until Mr. Turner returned. Applicant is encouraged to contact the

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Examiner upon receiving this action if they are interested in expediting allowance of this Application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

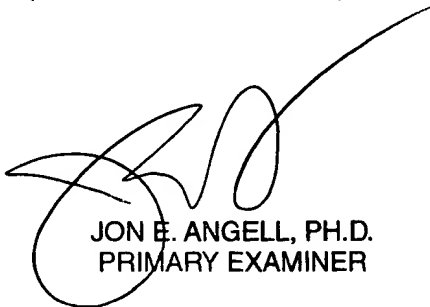
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Eric Angell whose telephone number is 571-272-0756. The examiner can normally be reached on 9:00 a.m.- 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.E. Angell
AU 1635



JON E. ANGELL, PH.D.
PRIMARY EXAMINER